AMENDMENT AND RESPONSE UNDER 37 C.F.R. 1.116
Applicant: Travis J. Parry et al.
Serial No.: 10/037,685
Filed: October 24, 2001
Docket No.: 10006365-1
Title: NETWORK SYSTEM AND METHOD FOR AUTOMATIC PRINTING OF DIGITAL
PHOTOGRAPHS

REMARKS

The following remarks are made in response to the Office Action mailed February 2, 2005. Claims 1-28 were rejected. Claim 26 has been canceled. With this Response, claims 1, 21, 22 and 28 have been amended. Claims 1-28 remain pending in the application and are presented for reconsideration and allowance.

Claim Rejections under 35 U.S.C. § 102

In the Office Action, claims 1-12, 19-21, and 28 were rejected under 35 U.S.C. 102(e) as being anticipated by Tonkin U.S. Patent 6,134,568 (herein Tonkin).

Applicant does not admit that Tonkin is prior art and reserves the option of swearing behind Tonkin.

Tonkin fails to disclose numerous aspects of Applicant's independent claim 1.

First, Tonkin fails to disclose a user printer, a network site, and a sender that are independent of and separate from each other.

In one aspect, a user printer, as claimed by Applicant, cannot be equated with a document production location, as asserted in the Office Action. As commonly understood to those skilled in the art, and as used in the specification, a user printer as claimed by Applicant refers to a device (e.g., printer, multifunction printer, etc.) but does not refer to a location or business, such as document production location 71-73, as used in Tonkin, in which personnel would be involved in physically producing and assembling a document according to an order received from processing facility 60. See Tonkin at Column 13, lines 65-67 and Column 14, lines 1-24.

Moreover, the document production locations 71-73, which were asserted in the Office Action to be a user printer, operate in cooperation with a processing facility 60, which is a commercial entity at which a customer makes a document request. See Tonkin at Column 13, lines 17-20. While Figure 2 appears to show document production location (71-73) being physically separate from processing facility 60, these two entities are not independent of each other. Instead, document production location 71-73 acts to carry out a document order in response to a message from (i.e., upon direction from) processing facility 60. See Tonkin at Column 13, lines 52-54.

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Moreover, as revealed by Figure 1, printing of a document order does not occur at terminals 31 or 32. Accordingly, terminals 31 or 32 in Tonkin also cannot be equated to a user printer, as claimed by Applicant.

Accordingly, in Tonkin there is no entity corresponding to the user printer. Therefore, Tonkin also fails to disclose other aspects of Applicant's independent claim 1 that specify a user printer.

In further contrast to Applicant's independent claim 1, Tonkin fails to disclose registering a user printer with the network site, because document production locations 71-73 are already in a commercial relationship with processing facility 60 to perform document assembly on behalf of processing facility 60. See Tonkin at Column 13, lines 52-67 and Column 14, lines 1-24.

Moreover, the document production locations 71-73 do not request images from the processing facility 60, whereas the user printer in Applicant's independent claim 1 makes at least one automatic image request of the network site. Rather, Tonkin discloses an arrangement opposite of that claimed by Applicant, in which processing facility 60 in Tonkin makes a request of the document production locations 71-73 by sending a message regarding an order (for a document) to document production locations 71-73. See Tonkin at Column 13, lines 52-55. Accordingly, the document production locations 71-73, asserted to be a user printer in the Office Action, do not register with a network site and do not make at least one automatic image request as in Applicant's claimed method, and therefore are substantially different than a user printer, as claimed by Applicant.

Consequently, Tonkin also fails to disclose capturing, via the user printer, the at least one image from the network site because processing facility 60 sends orders to document production locations 71-73 and document production locations 71-73 do not capture images from processing facility 60.

For these reasons, Tonkin does not disclose, teach or suggest Applicant's amended independent claim 1. Accordingly, Applicant's believe that independent claim 1 is allowable over Tonkin. Claims 2-20 are believed to be allowable as well based on their dependency from independent claim 1.

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For substantially the same reasons as presented for patentability of claim 1, Tonkin fails to disclose Applicant's amended independent claim 28 which is directed to a computer readable medium having computer-executable instructions for performing a method of automated printing of an image at a user printer -- the method including substantially the same limitations as claim 1. For these reasons, Tonkin fails to teach or suggest amended independent claim 28, and therefore Applicant's amended independent claim 28 is patentable and allowable over Tonkin.

Applicant's amended independent claim 21 is directed to a method of automated printing of a digital photograph to enable automatically printing at least one digital photograph at a user printer. For substantially the same reasons as presented for patentability of Applicant's independent claim 1, Tonkin fails to disclose Applicant's independent claim 21. In particular, Tonkin fails to disclose a sender interface, a user printer, and a website that relate to each other in the manner specified in Applicant's independent claim 21. For these reasons, Tonkin does not disclose, teach or suggest Applicant's amended independent claim 21. Accordingly, Applicant's believe that independent claim 21 is patentable and allowable over Tonkin.

In the Office Action, claims 1 and 13-18 were rejected under 35 U.S.C. 102(e) as being anticipated by Kelley U.S. Patent 6,320,671 (herein Kelley).

Applicant does not admit that Kelley is prior art and reserves the option of swearing behind Kelley.

Kelley fails to disclose a user printer, a sender, and a network site which are independent of and separate from each other and wherein the sender posts at least one image at the network site, as claimed by Applicant. In Kelley, printer 30 is not independent of client computer 10, as printer 30 is connected to client computer 10 (Column 4, lines 65-67) for printing lists or web pages stored in database 16 of client computer 10.

In further contrast to Kelley, the user printer claimed by Applicant captures and prints at least one image from a network site that is independent of and separate from the user printer. Moreover, in Applicant's claimed method, the user printer – not a client computer 10

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as in Kelley – determines whether there an at least one image has been posted at a network site. Likewise, in Applicant's claimed method, the user printer – not a client computer 10 as in Keeley – automatically captures the at least one image posted at the network site.

In further contrast to Kelley, in Applicant's claimed method, a sender posts at least one image to a network site. The Office Action asserts client computer 10 to be a "sender" ; however, client computer 10 does not post at least one image at a network site, as claimed by Applicant, particularly where that at least one image is later automatically captured to a user printer and automatically printed at the user printer, as claimed by Applicant.

For these reasons, Kelley does not disclose, teach or suggest Applicant's amended independent claim 1. Accordingly, Applicant's believe that independent claim 1 is allowable over Kelley. Claims 13-18 are believed to be allowable as well based on their dependency from independent claim 1.

In the Office Action, claims 22-27 were rejected under 35 U.S.C. 102(e) as being anticipated by Garcia U.S. Patent Publication 2003/0048470 (herein Garcia).

Applicant does not admit that Garcia is prior art and reserves the option of swearing behind Garcia.

Garcia is directed to a web browser 23 for a network printer 12 and includes embedded web server 120. Printer 12 of Garcia enables a user to access a web site 104 via web browser 23. However, printer 12 in Garcia does **not**, as part of a system for automated printing of an image at a user printer, <u>directly automatically determine</u> whether an at least one image has been posted at a network site and <u>directly automatically capture to the user printer</u> the at least one image posted at the network site. Consequently, Garcia does not disclose automatically printing the captured at least one image at the user printer, as claimed by Applicant.

For these reasons, Garcia does not disclose, teach or suggest Applicant's amended independent claim 22. Accordingly, Applicant's believe that independent claim 22 is allowable over Garcia. Claims 23-27 are believed to be allowable as well based on their dependency from independent claim 22.

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In light of the above, Applicants respectfully request withdrawal of the rejection of claims 1-25 and 27-28 based on Tonki, Kelley, and/or Garcia under 35 U.S.C. §102.

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CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-25 and 27-28 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-25 and 27-28 is respectfully requested.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to either Gregg W. Wisdom at Telephone No. (360) 212-8052, Facsimile No. (360) 212-3060 or Steven E. Dicke at Telephone No. (612) 573-2002, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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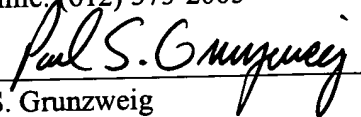Fort Collins, Colorado 80527-2400
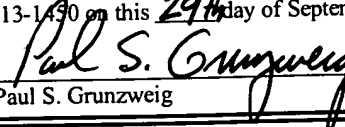
Respectfully submitted,

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